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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,038	09/17/1999	AKEO MARUYAMA	0557-4774-2	9584
22850	7590	01/30/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EBRAHIMI DEHKORDY, SAEID	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/398,038

Examiner

Saeid Ebrahimi-dehKordy

Applicant(s)

MARUYAMA, AKEO

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 6 AND 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-5, 7-11 and 13-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/12/03 has been entered.
2. Applicant's arguments with respect to claim 1-5, 7-11 and 13-14 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-11 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okimoto et al (U.S. patent 6,310,694) in view of Kimishima (U.S. patent 5,978,846)

Regarding claims 1, 10 and 11 Okimoto et al disclose: An electronic mail transmitting apparatus for transmitting document data via electronic mail, said electronic mail transmitting apparatus comprising: an application program for producing document data (please note Fig.1 column 9 lines 5-10 where the user uses the application

Art Unit: 2626

program to create the data in the host computer) said application program having a function to send a print instruction to print the document data (please note Fig.1 column 9 lines 11-12 where the application program is been sent to the printer through the command form the application program) and a printer driver activated by the print instruction of said application program (please note Fig.3 column 9 lines 12-15 where the printer driver 30 is activated through the application program) said printer driver having a function to convert the document data provided by said application program into a predetermined data format and a function to transmit the converted document data via electronic mail (please note Fig.4 column 10 lines 32-40 where the print data is converted to the predetermined format in this case PDL also please note Fig.3 where utility 31a is transmitting email data, column 7 lines 15-21).

However Okimoto et al does not disclose: wherein the printer driven' is capable of selecting the predetermined data format suitable for the electronic mail transmission from among a plurality of data formats other than a page description language (PDL) format. On the other hand Kimishima discloses: wherein the printer driven' is capable of selecting the predetermined data format suitable for the electronic mail transmission from among a plurality of data formats other than a page description language (PDL) format (please note column 7 lines 66-67 and column 8 lines 1-34 where the transmitting side is selecting a suitable format to transmit the data to the other side).

Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Okimoto et al's invention according to the teaching of Kimishima, Kimishima in the same field of endeavor teaches the way the

Art Unit: 2626

communication data could be made to make the print data at the transmitting side to be formatted to fit the receiving side.

Regarding claim 2 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver transmits the converted document data by attaching to an electronic mail as an attachment file (please note Fig.7 column 13 lines 16-49 and column 14 lines 1-8 where the data is attached to the mail and transmitted to the printer of destination location).

Regarding claim 3 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a bit-map image format (column 21 lines 46-61).

Regarding claim 4 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a document reader software format (please note column 10 lines 33-38).

Regarding claim 5 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a text format (please note column 25 lines 63-67).

Regarding claim 7 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is one of a hyper text markup language (HTML) format and a standard generalized markup language (SGML) format (please note column 25 lines 63-67).

Art Unit: 2626

Regarding claim 8 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver has a function to manage information regarding electronic mail addresses (please note column 6 lines 15-28).

Regarding claim 9 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver has a function to edit a text of an electronic mail to be transmitted (please note column 10 lines 66-67 and column 11 lines 1-15).

Regarding claim 13 Okimoto et al disclose: The processor readable medium as claimed in claim 11, wherein said third program code means includes program code means for inputting an electronic mail address of a remote party to which the document data is sent via electronic mail (please note column 6 lines 15-28).

Regarding claim 14 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in Claim 1, wherein said printer driver includes means for determining the predetermined data format suitable for the electronic mail transmission being performed (please note column 26 lines 1-4).

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, or (703) 308-9052 (for **formal** communications; please mark
"EXPEDITED PROCEDURE")

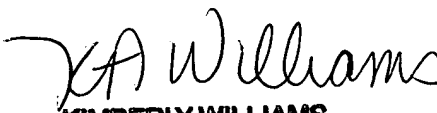
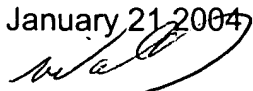
Or:

(703) 306-5406 (for **informal** or **draft** communications, please label
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy
Patent Examiner
Group Art Unit 2626
January 21, 2004



KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER